

REMARKS

Claims 13 to 15 and 18 to 24 are pending in the present application.

It is respectfully submitted that the presently pending claims are allowable, and reconsideration is respectfully requested.

It is believed and respectfully submitted that the present Office Action should not have been designated as final. As stated in M.P.E.P. § 1207.04, an Office Action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an IDS under 37 C.F.R. § 1.97(c) where no statement under 37 C.F.R. § 1.97(e) was filed. The present Office Action includes a new ground of rejection, which was neither necessitated by an amendment of the claims nor based on information submitted in an IDS under 37 C.F.R. § 1.97(c).

*For example, in the present Office Action, claims 13, 14, 18 and 20 to 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over German Patent No. DE 41 26 454 to Gruendl et al. ("Gruendl") in view of U.S. Patent No. 7,394,298 to Hazucha et al. This ground of rejection was not present in the only prior Office Action of December 30, 2008 and this new ground of rejection was **not** necessitated by an amendment to the claims by Applicants as asserted in the Final Office Action at pg. 4 because the amendments to claim 13 only added elements from canceled claims 16 and 17, which elements were already present in the claims prior to the amendment. The new grounds of rejection were also **not** based on information submitted in an IDS under 37 C.F.R. § 1.97(c).*

Withdrawal of the finality of the present Office Action is therefore respectfully requested.

Claim 14 was rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

The indefiniteness rejection of claim 14 is respectfully traversed. Claim 14 depends from claim 13, and it therefore does not cover any process, since it is limited by claim 13. Furthermore, claim features must be read in light of the specification. Claim 14 provides that the application process is not drive-relevant, as disclosed in the Specification at page 3, lines 18 to 29. Furthermore, as explained by M.P.E.P. Section 2173.04, breadth is not indefiniteness, so that breadth of a claim is not to be equated with indefiniteness. *In re*

Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the claimed subject matter to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Accordingly, claim 14 is allowable, and withdrawal of the indefiniteness rejection is therefore respectfully requested.

Claims 13, 14, 18 and 20 to 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over German Patent No. DE 41 26 454 to Gruendl et al. (“Gruendl”) in view of U.S. Patent No. 7,394,298 to Hazucha et al. (“Hazucha”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Hazucha reference, U.S. Patent No. 7,394,298, issued on July 1, 2008 and published as U.S. Patent Application Publication No. 2006/0033553 on February 16, 2006, and was filed as U.S. Patent Application Serial No. 10/919,672 on August 16, 2004. These dates are after the June 17, 2004 PCT filing date of PCT/EP2004/006508 of the present

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application, which is a U.S. national phase application thereof. Accordingly, the Hazucha reference is not prior art as to the present application.

It is therefore respectfully requested that the obviousness rejections of claims 13, 14, 18 and 20 to 24 be withdrawn.

Claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over Gruendl in view of U.S. Patent No. 5,497,038 ("Sink").

Claim 15 depends from claim 13 and it is therefore allowable for the same reasons as claim 13, as explained above. This is because Sink does not cure – and is not asserted to cure -- the deficiencies of Gruendl as to claim 13 as explained above.

Accordingly, it is respectfully submitted that claim 15 is allowable. It is therefore respectfully requested that the obviousness rejection of claim 15 be withdrawn.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 13 to 15 and 18 to 24 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since they have been obviated. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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